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| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | EXAMINER STILES, WESLEY L | |
| | | | ART UNIT 2616 | PAPER NUMBER 5 |

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,150

Applicant(s)

NAGUMO, FUMIO

Examiner

Wesley Stiles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 6, 10 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to because the arrow connecting the combiner 26 with the broadcast contents recording means 23 should apparently be pointing in the opposite direction. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.
2. The form and legal phraseology often used in patent claims, such as "means", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
3. The disclosure is objected to because of the following informalities:
4. On page 1, "there exist the pattern" should apparently be "there exists the pattern". Also on page 1, the phrase "created a problem that the viewer's desire to the CM broadcasting" is not understood by the examiner.

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5. On page 3, the phrase "the broadcast receiving device that makes the viewer can set the condition of broadcast contents, we provide the broadcast receiving device comprising" and the phrase "broadcast receiving method that makes the viewer can set" are not understood by the examiner.
 6. On page 6, the phrase "As the display condition to be set, such as CM will be displayed or not" is not understood by the examiner.
 7. On page 7, the phrase "owned by the viewer per channel" is not understood by the examiner.
 8. On page 9, the phrase "upon receiving the customer requirement such as customer information" is not understood by the examiner.
 9. On page 10, "progrm" should apparently be "program".
 10. On page 11, "transmssion" should apparently be "transmission".
- Appropriate correction is required.

Claim Objections

11. Claims 6 and 10 are objected to because of the following informalities: "aaid" in claim 6 should apparently be "said" and "deice" in claim 10 should apparently be "device". Appropriate correction is required.
12. Claim 15 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 14. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
14. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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15. Claim 6 recites the limitation "said recording means" in the "control data forming step". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-9 and 11-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Zigmond (US 6,698,020).

3. In regards to claim 1, Zigmond discloses an information receiving device that allows the user to set the conditions that determine which information is displayed. As shown in column 4, lines 16-24, the "information" broadcast in his system comprises both programming and commercial information. Also taught by Zigmond is a recording means to store the aforementioned information (column 10, lines 18-22), condition setting means whereby the user sets the conditions used to select which advertisements are to be displayed (column 10, lines 35-39), inherent control data forming means for forming control data (which must be present in order to turn the user input into computer readable data) which are supplied to the recording means (column 10, lines 30-34), and data transmission means for transmitting condition data back to the source. This data transmission means is inherent in that an auto-feedback loop is established with the advertising source wherein the advertisers can edit information in the ads or alter a viewer's criteria (column 4, lines 60-65). The ability to alter a viewer's ad selection criteria implies that the original viewer criteria are transmitted and available to the advertising source. Also, the combination of programming information and commercial information to be shown to the viewer is set by the recording means (column 11, lines 43-47). The viewer information, which tells the system how many commercials to play, if any at all, is found in the recording means.

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4. In regards to claim 2, all limitations are met as discussed for claim 1 above, wherein Zigmond also discloses that the condition setting means is responsible for changing the combination ratio of programming information and commercial information (column 17, lines 37-42). If the user chooses via the condition setting means to view more commercials, then more are shown. Zigmond also teaches the ability of the user to pay an increased fee to remove commercials altogether. This is another way of altering the combination ratio of programming and commercial information (column 14, lines 28-32).

5. In regards to claim 3, all limitations are met as discussed for claim 1 above, wherein Zigmond also discloses that the condition setting means is capable of deleting commercial information. Zigmond teaches a step in Figure 6 of his disclosure labeled "Filter Downloaded Ads According to Criteria". Filtering downloaded ads is equivalent to deleting commercial information based on the conditions set by the user. Also, Zigmond teaches that advertisements can be replaced with effectively targeted ads based on any other criteria" in column 14, lines 11-12. This also implies the ability of the condition setting means (criteria entered by the user) to delete (replace) commercial information.

6. In regards to claim 4, Zigmond discloses all of the limitations of the claim, wherein the condition setting means (user input of advertising selection criteria) may be set to "request or block advertisements for selected classes of goods and services" (column 14, lines 24-26), where the user sets the condition and the hardware selects the appropriate commercial information.

7. In regards to claim 5, Zigmond discloses all of the limitations of the claim, including information consisting of program and commercial information, recording means (column 17, lines 10-20), condition setting means, control data forming means, data transmission means, and the responsibility of the recording means to set the combination of the program and commercial information. These limitations are discussed in greater detail for claim 1 above. In addition, Zigmond teaches that the recording means also records the information related to the commercial information selected. Zigmond teaches of pre-filtering the incoming advertisements, storing only those ads that correspond with the user conditions set via the condition setting means. See column 15, lines 17-23.

8. In regards to claim 6, Zigmond discloses all of the claimed limitations of the method, including information consisting of program and commercial information, recording the information (downloading

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the advertisements), setting the conditions (via user input), forming control data and supplying to recording means, data transmission to supplier, and setting the combination of programming and commercial information. The disclosure of all steps is discussed in greater detail in accordance with claim 1 above.

9. In regards to claim 7, all limitations are met as discussed for claim 6 above, wherein Zigmond also discloses that the condition setting step changes the information ratio displayed to the user (column 14, lines 28-32 and column 17, lines 37-42).

10. In regards to claim 8, all limitations are met as discussed for claim 6 above, wherein Zigmond also discloses that the condition setting step makes the deletion of commercial information possible. See column 14, lines 11-12 and Figure 6 of Zigmond, along with the detailed explanation for claim 3 above.

In regards to claim 9, Zigmond discloses all of the limitations of the claim, wherein the condition setting means (user input of advertising selection criteria) may be set to "request or block advertisements for selected classes of goods and services" (column 14, lines 24-26) as discussed previously.

11. In regards to claim 11, Zigmond discloses a broadcast receiving device with both program and commercial receiving means (column 7, lines 13-36), broadcast contents recording means (column 17, lines 10-20), combining means as discussed above, and a control means for controlling contents to be displayed (video switch of column 8, lines 32-35 and Figure 4).

12. In regards to claim 12, Zigmond discloses that if the user chooses to view the broadcast without commercials and pays a fee to do so, that information is store with the viewer information which is responsible for displaying or not displaying commercial messages. See column 14, lines 28-32.

13. In regards to claim 13, Zigmond discloses that the condition setting means selecting the commercial message to be displayed (column 11, lines 31-34).

14. In regards to claim 14, Zigmond discloses a control means (video switch of column 8, lines 32-35) which is responsible for inserting the ad information into the programming information (column 7, lines 26-34). Also see Figures 2A and 2B.

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15. In regards to claim 15, Zigmond discloses all limitations of the claim (see claim 14 for explanation).

16. In regards to claim 16, Zigmond discloses that the execution of a commercial message broadcast is can be transmitted to an outside party for feedback purposes (column 9, lines 21-38).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Kitsukawa (US 6,282,713). Zigmond discloses an information receiving device (column 6, lines 40-47) connected to the supplier via a bidirectional circuit (met by cable modem or internet of column 10, lines 4-7) which receives program and commercial information from the supplier and transmits the condition setting request related to commercial information to the supplier. In addition, he teaches recording means, combining means for combining the commercial and program information (column 7, lines 26-33) and for changing the combination ratio of program information to commercial information, condition setting means, and condition data forming means as discussed previously. Also, Zigmond discloses addition information request generating means for requesting additional information about commercial information from the supplying source (column 18, lines 39-48 and column 19 lines 10-11). Zigmond does not expressly disclose, however, the storage of the additional information onto the recording medium.

19. In analogous art, Kitsukawa discloses the ability to store requested additional advertising information onto the receiving memory device. In the disclosure of Kitsukawa, advertising and coupon data is stored and shown when a user wishes to view it (column 6, lines 8-13)

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20. At the time of the invention, it would have been obvious to one of ordinary skill in the art to store the additional information collected by the receiving device of Zigmond onto a recording medium in the method taught by Kitsukawa. The motivation for doing so would be to allow the user to request additional information and view it at a later time as to not disrupt the scheduled commercial and programming broadcast. Therefore, it would have been obvious to one of ordinary skill in the art to combine the storage method of Kitsukawa with the receiver system of Zigmond to store the additional information from a commercial message onto a recording medium in order to allow the user to view the information at his or her convenience.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley Stiles whose telephone number is (703) 308-6107. The examiner can normally be reached on 7:00-4:30, out of the office on alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WLS
8/11/04


VIVEK SRIVASTAVA
PRIMARY EXAMINER